

REMARKS/ARGUMENTS

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks. Claims 1, 4-7, 12 and 16-23 remain pending.

In the Office Action, the Examiner rejects claim 4 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Applicants do not necessarily agree. However, to promote prosecution progress of the application, claim 4 is amended to address this issue. It is intended that the scope of claim 4 remains substantially the same. Applicants respectfully request that the § 112, second paragraph rejection of claim 4 be withdrawn.

In the Office Action, the Examiner makes the following rejections based on prior art:

- claims 1, 5, 7, 17 and 19 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hashimoto (JP409194107) in view of Norris (U.S. Patent No. 4,847,632);
- claim 6 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hashimoto in view of Norris, and further in view of Ishikawa et al. (U.S. Patent No. 4,838,534);
- claims 4, 18, 20, 21 and 23 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hashimoto in view of Yamamoto et al. (JP 2003002508);

- claim 12 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hashimoto in view of Yamamoto et al., and further in view of Cho (U.S. Patent No. 5,974,283);
- claim 16 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hashimoto in view of Yamamoto et al. and Nose (U.S. Patent No. 6,522,860); and
- claim 22 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hashimoto in view of Yamamoto et al., and further in view of Ishikawa et al.

Applicants respectfully traverse each rejection. In rejecting claim 1, the Examiner correctly recognizes that Hashimoto does not teach or suggest the feature of:

wherein the side wall member is arranged to receive a biasing force to the upright state by the biasing member and is configured to move from the upright state to the laid flat state against the biasing force by the biasing member only upon receiving an external force from the recording medium having a discharge speed greater than a predetermined speed or having a hardness greater than a predetermined hardness when the recording medium has been discharged to the discharge space in the upright state of the side wall member that closes the open position.

To correct this deficiency of Hashimoto, the Examiner proposes to modify Hashimoto's device with the teachings of Norris which allegedly teaches the above-recited feature.

It is well established that the proposed modification cannot render the applied reference unsatisfactory for its intended purpose. *See M.P.E.P.*

2143.01. Thus, if the proposed modification renders the cited reference unsatisfactory for its intended purpose, the rejection must also fail.

In this instance, even it is assumed for the moment that Norris does teach the recited feature, modifying as the Examiner proposes would leave Hashimoto unsatisfactory for its intended purpose. Therefore, the rejection is improper and fails.

Hashimoto is directed toward a paper processing unit which processes papers such as a copying machine, a printer, and so on. According to Hashimoto, when there is sufficient space, having 1st and 2nd trays extended out like in the paper delivery position is not an issue. However, when the space becomes an issue such as a narrow office, there is a problem that the pulled-out tray portion becomes obstructive. *See Hashimoto, [0003].*

As a solution to this problem, Hashimoto provides a delivery tray 7 of a paper processing unit as illustrated in Figure 1. The delivery tray 7 includes a first tray 11 that can be laid in the paper mounting surface 11a. *See [0018].* The delivery tray also includes a second tray 12 that is rotatable in the direction of arrow E between 1st and 2nd positions as illustrated in Figure 2. The 1st position is the extended position in the direction of arrow B and the 2nd position is the right angle to the paper mounting surface 11a. *See Figure 2; [0019].* Hashimoto discloses that the second tray 12 can be manually positioned anywhere between the 1st and 2nd positions by locating the lug 25 to one of multiple tooling holes 27. *See Figure 9; [0031].*

Hashimoto explicitly discloses that when the delivery tray 7 is to be placed in a narrow place, the second tray 12 being extended out becomes obstructive. *See [0039].* As a solution, the second tray 12 can be rotated to the 2nd position, i.e., in the upright state. When the second tray 12 is upright, the intermediate guide 17 pushes upwards out of the paper mounting surface 11a. *See [0040].* Because of the curvature of the intermediate guide 17, the discharged paper will curve and rise up, and thus, can be taken out easily. *See Figure 3; [0042].*

According to Hashimoto, when the second tray 12 is in the 2nd (upright) position, the second tray 12 must maintain its upright state. The second tray 12 cannot move from the upright state to the laid flat state (1st position) since this would defeat the purpose of being able to locate the paper processing unit in narrow spaces.

It is clear that regardless of what Norris teaches, Hashimoto cannot be modified as the Examiner proposes since in doing so would render Hashimoto unsatisfactory for its intended purpose. That is, Hashimoto directly teaches away. *See KSR International v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007) (invention is more likely to be non-obvious when prior art teaches away). Therefore, independent claim 1 is distinguishable over the combination of Hashimoto and Norris.

None of Ishikawa et al, Yamamoto et al, Cho, and Nose et al corrects the deficiencies of Hashimoto and Norris. Therefore, independent claim 1 is

distinguishable over any combination of Hashimoto, Norris, Ishikawa et al, Yamamoto et al, Cho, and Nose et al. For similar reasons, independent claim 4 is distinguishable over the applied references in any combination. By virtue of their dependencies from independent claims 1 and 4 as well as on their own, dependent claims 5-7, 12 and 16-23 are distinguishable over any combination of Hashimoto, Norris, Ishikawa et al, Yamamoto et al, Cho, and Nose et al.

Applicants respectfully request that the rejections of claims based on applied references Hashimoto, Norris, Ishikawa et al, Yamamoto et al, Cho, and Nose et al be withdrawn.

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

The Commissioner is authorized to charge the undersigned's deposit account #14-1140 in whatever amount is necessary for entry of these papers and the continued pendency of the captioned application.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:



Hyung N. Sohn
Reg. No. 44,346

HNS/edg
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100